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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/843,106	04/25/2001	David Robert Dudek	TS9244 (US)	1059

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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 10/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/843,106

Applicant(s)

DUDEK ET AL.

Examiner

Mark Tremblay

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.135(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-7,9-18 and 20-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-7,9-18 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 7 and 18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Applicant: Dudek et al.

Filing date: 4/25/2001

Claim Rejections - 35 USC § 112

The previous rejection of claims 1-22 under 35 U.S.C. § 112 is withdrawn due to applicant's cancellation of claims 8 and 19, and the inclusion of the term "updateable". Bar codes and resistance tags are not generally considered "updateable". Even though a new bar code can be printed out and pasted over the old, this is not updating, but rather replacing. Resistance tagging likewise generally requires replacement of the tag, in order to encode any change in information, and therefore is not considered updateable, but replaceable, whereas a transponder tag can contain new, updated information without being replaced.

Claims 1 and 3-6 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Claim 1 recites "below the rigid upper portion", but this recitation lacks antecedent basis. Further, this recitation is repeated in claim 6. Claim 6 lacks any real substance if it merely repeats a limitation already present in the independent claim. Further, claims 3-6 recite dependency on claim 2, which has been canceled. Claims 3-6 will be treated by the Examiner as dependent on claim 1 for the purposes of this examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(c) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1, 3, 6 and 9-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,335,907 to Momich ("Momich" hereinafter). Momich discloses an inherently reusable container in figures 3 and 13 for household products, which comprises therein one or more

readable identification means 14 comprising an updatable electronic intelligent tag adapted to be reprogrammable with information related to one or more household products (medicines) stored in the reusable container, the container comprising an exterior collapsible portion (tube) below the rigid upper portion (cap). The tube is inherently reusable in at least two senses. First, it is understood to contain multiple portions, as are the containers of figures 1 and 2. The whole idea of the ID section 14 is based on the use of the container multiple times to dispense multiple portions. In the second sense, the tube is inherently reusable, in the sense that if it is filled once, it may be filled a second time. Examiner acknowledges that in common practice, such tubes are not refilled for reasons of convenience, lack of serious expense, possible product contamination, mess, etc. However, the finding of inherency has nothing to do with convenience, expense, contamination or mess. It is a bald finding that medication inherently can be replaced in the tube through the same opening that dispenses the medication. Applicant's term "reusable" in the context of claims 1, 3, 6 and 9-11 is not paired with qualifying structural limitations that would render irrelevant the Examiner's finding.

Claims 1-4, 6, 9-15, 17, and 20-24 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,426,699 to Porter (" '699 " hereinafter), which incorporates U.S. Patent #5,774,053 to Porter (" '553 hereinafter) by reference. See column 5, lines 7-9 of '699. '699 teaches a reusable container for household products (see figures) which comprises therein one or more readable identification means comprising an updatable electronic intelligent tag (the controller and memory 46 described in '533) adapted to be reprogrammable with information related to one or more household products (see column 5, lines 37-64 of '533) stored in the reusable container, the container comprising an exterior collapsible portion (104 in '699) below the rigid upper portion (102 in '699).

Re claim 9, the process of filling the container comprises reading an identification means comprising an adaptable electronic intelligent tag on the reusable container (the memory of the controller which stores vendor codes) during filling or refilling of a reusable container with the household products; and storing the information (the vendor message) obtained therefrom in a storage means (the memory) that is capable of being interrogated (e.g. by the modem) to extract

and optionally process the information.

Re claim 24, the memory is reprogrammed with new vendor messages, which tell what kind of products are stored (e.g. dry cleaning, groceries), the vendor messages being a specific case of the more generally recited "changed household product information".

Claims 1, 5, 12 and 16 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent #5,347,453 to Macstre ("Maestre" hereinafter). Macstre discloses a reusable container (see figure 10) for household products (medicine bottles 96), which comprises therein one or more readable identification means 8 comprising an updatable electronic intelligent tag adapted to be reprogrammable with information related to one or more household products stored in the reusable container, the container comprising an exterior collapsible portion (the straps) below the rigid upper portion 90. Note that Examiner considers the reusable container to be the invention shown in figure 10, analogous to that shown in figure 11, not the medicine bottle itself. The mounting support base may be made of an elastomeric material such as elastic, foam or rubber. See column 18, lines 60-64. Foam is inherently collapsible.

Claims 20-25 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,259,654 to de la Hueriga (" '654 " hereinafter). '654 teaches a process of using an identification means, comprising:

providing one or more identification means comprising an adaptable electronic intelligent tag with a household products (medicine) reusable (inherent) container; and

monitoring and recording household product information using the adaptable electronic intelligent tag during a refilling of the reusable container with one or more household products. See the summary of the invention, especially at column 5, line 57 through column 6, line 9.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #6,332,481, U. S. Patent #6,578,763, and U. S. Patent #4,929,818 are cited for showing other reusable containers with electronic identification means.

U. S. Patent #5,980,501 is cited for showing a collapsible container with an electronic ID.

Remarks

Applicant's arguments with respect to the claims have been considered but are moot in
5 view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 7 and 18 are objected to as being dependent upon a rejected base claim, but would
be allowable if rewritten in independent form including all of the limitations of the base claim and
10 any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: The
prior art teaches the use of refillable containers with remotely located ports; see e.g. Pfeiffer et al.
Pfeiffer does not teach an external collapsible portion below a rigid portion. While the prior art as
a whole teach all of the individual features of the invention in different disclosures, there is no
15 suggestion or motivation to combine all the features recited in claims 7 and 18 in the absence of
Applicant's specification.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (703) 305-5176. The
20 Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is
available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner,
Michael Lee, can be reached on (703) 305-3503. Technical questions and comments concerning
PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or
(703) 308-4357.

Fax Procedures

Application papers may faxed to Art Unit 2876 at (703)872-9306. Faxes must conform
with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Papers solely
for the examiner's consideration, and not intended for immediate entry into the application (e.g., a
proposed amendment) should be unsigned and clearly marked "Draft Copy" and faxed to (703)
30 746-5577.


MARK TREMBLAY
PRIMARY EXAMINER

September 23, 2003